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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,444	02/24/2004	Anthony Pantages	16497.4.1	4902
57360	7590	10/30/2006	EXAMINER	
WORKMAN NYDEGGER 1000 EAGLE GATE TOWER, 60 EAST SOUTH TEMPLE SALT LAKE CITY, UT 84111			YABUT, DIANE D	
			ART UNIT	PAPER NUMBER
			3734	

DATE MAILED: 10/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/786,444	PANTAGES ET AL.
	Examiner Diane Yabut	Art Unit 3734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 24 February 2004.
- 2a) This action is **FINAL**.                                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 4 and 11 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-3,5-10, and 12-22 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 24 February 2004 is/are: a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 2/24/2004.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_.

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121.

This application contains claims directed to the following patentably distinct species of the claimed invention. The species are as follows:

<b><u>Species</u></b>	<b><u>Figure(s)</u></b>
1	1-2, 4-6G
2	3A
3	3B
4	7-10

Generic claim is Claim 1.

2. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

3. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

4. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations

of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

5. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

6. The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

7. Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

8. During a telephone conversation with Fraser Roy on Monday, October 2, 2006 a provisional election was made without traverse to prosecute the invention of Species 1 directed towards Figures 1-2 and 4-6G and Claims 1-3, 5-10, and 12-22. Because applicant did not distinctly and specifically point out the supposed errors in the

restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

9. Affirmation of this election must be made by applicant in replying to this Office action. Claim 4, which reads on Species 2, and Claim 11, which reads on Species 4, are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to non-elected inventions.

#### ***Information Disclosure Statement***

10. The information disclosure statement (IDS) submitted on 24 February 2004 is acknowledged. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

#### ***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1, 2, 3, 5, 7-10, and 12-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Green et al., or **Green** (U.S. Patent No. 5,674,231) in view of Martinez et al., or **Martinez** (U.S. Patent No. 5,593,412).

Claims 1, 17, 19, 20, and 22: Green discloses a method for delivering a closure element **102** in a blood vessel **104**, the closure element being carried by a carrier

assembly **42** slidable on an outer surface of an elongate member **30**, the elongate member comprising and at least partially overlying the carrier assembly, the elongate member being provided with a locator member **60** slidably associated therewith, the locator member having one or more expandable positioning elements **62, 64** on its distal portion, the method comprising inserting the distal end of the elongate member into an opening through tissue, advancing the locator member distally from the distal end of the elongate member, expanding the one or more positioning elements, withdrawing the locator member until the positioning elements contact tissue, advancing the carrier assembly towards the distal end of the elongate member, and deploying the closure element from the carrier assembly within the opening to substantially seal the opening (Figures 1-4, 7, 10-11 and col. 5, lines 45-67, col. 6, lines 1-8, col. 7, lines 18-67, col. 8, lines 1-52). Green discloses the claimed invention except for a skin, or sleeve member, overlying at least a portion of the outer surface between the carrier assembly and a distal end of the elongate member and a the carrier assembly causing the skin to separate from the outer surface of the elongate member as the carrier assembly is advanced towards the distal end.

Martinez teaches a skin, or sleeve, **18** overlying at least a portion of the outer surface between the carrier assembly and a distal end of the elongate member and the carrier assembly causing the skin to separate from the outer surface of the elongate member as the carrier assembly is advanced towards the distal end (Figures 1-5 and col. 4, lines 53-67 and col. 5, lines 1-2). It would have been obvious to one of ordinary skill in the art at the time of invention to provide a skin, as taught by Martinez, to Green

since it was known in the art that skins or sheaths are commonly used in deployment devices to protect delivery devices and are often opened or removed in order to unveil the delivery device.

Claim 2: Green discloses removing the elongate member from the opening (col. 8, lines 44-52).

Claims 3 and 5: Green discloses the claimed invention except for the skin comprising a weakened region extending towards the distal end of the elongate member, the weakened region tearing as the carrier assembly is advanced towards the distal end of the elongate member, and the skin expanding to a cross-section that is larger than a cross-section of the elongate member as the carrier assembly is advanced towards the distal end.

Martinez teaches a skin comprising a weakened region extending towards the distal end of the elongate member, the weakened region tearing as the carrier assembly is advanced towards the distal end of the elongate member, and the skin expanding to a cross-section that is larger than a cross-section of the elongate member as the carrier assembly is advanced towards the distal end (Figures 1-5 and col. 4, lines 53-67 and col. 5, lines 1-2). It would have been obvious to one of ordinary skill in the art to provide a skin with a weakened region, as taught by Martinez, to Green since it was known in the art that skins or sheaths are commonly used in deployment devices to protect delivery devices with weakened regions to serve as a simple opening mechanism that does not require a second instrument or mechanism.

Claim 7: Green discloses the claimed invention except for the skin comprising an outer surface that is substantially slippery for facilitating advancement of the elongate member into the opening through tissue.

Martinez teaches the skin comprising an outer surface that is substantially slippery for facilitating advancement of the elongate member into the opening through tissue and that it allows for retraction of the sheath and allows for expansion for the element onto which it is disposed (col. 3, lines 30-42 and col. 4, lines 53-67 and col. 5, lines 1-2). It would have been obvious to one of ordinary skill to provide a skin with a slippery outer surface, as taught by Martinez, to Green since it was known in the art that a lubricated, slippery surfaces allow for facilitated translational movement and also in order to allow for expansion of the elongate member or the element onto which it is disposed.

Claim 8: Green and Martinez disclose the claimed invention except for the opening through tissue extending through one or more layers of fascia, and wherein the skin facilitates advancement of the carrier assembly through the one or more layers of fascia. It would have been obvious to one of ordinary skill in the art for the skin to facilitate advancement of the carrier assembly through one or more layers of fascia, or connective tissues of the blood vessel, in Green and Martinez, since it was known in the art that sheaths and skins protect as well as facilitate advancement of deployment devices through layers of tissue in the surgical site.

Claim 9: Green discloses the opening through tissue communicating with a blood vessel, and wherein the deploying step comprises substantially sealing the opening

from blood flow therethrough with the closure element. See explanation for Claims 1, 17, 19, 20, and 22 above.

Claim 10: Green discloses coupling the carrier assembly to a proximal end of the elongate member. See explanation for Claims 1, 17, 19, 20, and 22 above.

Claims 12-13: Green discloses the claimed invention except for the skin comprising a plurality of longitudinal slots, the slots opening as the carrier assembly is advanced, thereby expanding the skin, and the slots being staggered relative to one another such that the skin assumes a zigzag mesh configuration as it expands.

Martinez teaches a skin comprising a plurality of longitudinal slots, the slots opening as the carrier assembly is advanced, thereby expanding the skin, and the slots being staggered relative to one another such that the skin assumes a zigzag mesh configuration as it expands (Figures 1-5 and col. 4, lines 53-67 and col. 5, lines 1-2). It would have been obvious to one of ordinary skill in the art to provide a skin having a plurality of slots assuming a zigzag mesh configuration, as taught by Martinez, to Green since it was known in the art that this configuration allows for more flexibility and lateral, axial, and longitudinal expansion.

Claim 14: Green discloses contracting said positioning elements and withdrawing said locator member. See explanation for Claims 1, 17, 19, 20, and 22 above.

Claim 15: Green discloses the distal end of the elongate member being inserted into the lumen of a blood vessel and wherein the positioning elements of the locator member are expanded within the lumen of a blood vessel. See explanation for Claims 1, 17, 19, 20, and 22 above.

Claim 16: Green discloses the step of withdrawing the locator member causes the positioning elements to come into contact with the wall of the blood vessel. See explanation for Claims 1, 17, 19, 20, and 22 above.

Claims 18 and 21: Green and Martinez disclose the claimed invention except for the blood vessel being the femoral artery. It would have been obvious to one of ordinary skill to provide the blood vessel as being a femoral artery in Green and Martinez, since it was known in the art that the femoral artery is a blood vessel and that the vascular hole closure device and method may be applied to any blood vessel.

13. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Green** (U.S. Patent No. **5,674,231**) and **Martinez** (U.S. Patent No. **5,593,412**), as applied to Claim 1 above, and further in view of Kanner et al., or **Kanner** (U.S. Patent No. **5,868,755**).

Claim 6: Green and Martinez disclose the claimed invention except for the skin being bonded to the outer surface of the elongate member by an adhesive and wherein the adhesive has sufficient adhesive strength such that the skin is peeled away from the outer surface as the carrier assembly is advanced towards the distal end.

Kanner teaches a skin 1 being bonded to the outer surface of the elongate member by an adhesive and wherein the adhesive has sufficient adhesive strength such that the skin is peeled away from the outer surface as the carrier assembly is advanced towards the distal end (col. 4, lines 1-16). It would have been obvious to one of ordinary skill in the art to provide a skin bonded to the outer surface to the elongate

member, as taught by Kanner, to Green and Martinez, since it was known in the art to provide adhesives that provide temporary security and to avoid undesired movement of the sheath.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Diane Yabut whose telephone number is (571) 272-6831. The examiner can normally be reached on M-F: 9AM-4PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hayes can be reached on (571) 272-4959. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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MICHAEL J. HAYES  
SUPERVISORY PATENT EXAMINER

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